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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,979	09/10/2003	Gabriel Slup	10286.0292.CPUS04	3971
23369	7590	10/07/2005	BJSC:29	
HOWREY LLP C/O IP DOCKETING DEPARTMENT 2941 FAIRVIEW PARK DRIVE, SUITE 200 FALLS CHURCH, VA 22042-7195			EXAMINER THOMPSON, KENNETH L	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/658,979	Applicant(s) SLUP ET AL.	
	Examiner Kenn Thompson	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 45-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 10, 11, 16-19, 29-31, 38 and 41-44 is/are rejected.
- 7) ☒ Claim(s) 2, 4-9, 12-15, 20-28, 32-37, 39 and 40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/03; 2, 9, 11/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 45-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species I-X, XII and XIII, there being no allowable generic or linking claim. Applicant timely traversed the election requirement in the reply filed on 22 August 2005.

Applicant's election with traverse of Species XI in the reply filed on 22 August 2005 is acknowledged. The traversal is on the grounds that Species I-X are directed to embodiments searched and examined in related parent applications and that Species XII and XIII are not indicated to require a separate classification, status in the art or field search.

This is not found persuasive because the present application, a continuation-in-part application, may disclose and claim subject matter not disclosed in the prior applications; and applicant has not submitted evidence nor identified such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 16-19, 29-31 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Cherry et al., U.S. 3,375,874.

Regarding claims 1, 29 and 38, Cherry et al. discloses a hollow mandrel (312) having an inner diameter; a packing element (27) arranged about the mandrel; and a valve (75) functionally associated with the mandrel for selectively controlling flow of fluids through the passage, the valve (75) adapted (336, 330) to engage (332) the mandrel such that rotation between the mandrel and the valve is precluded when the valve is in a closed position (col. 12, lines 63-72). Cherry et al. disclose setting the packing element (27) by the application of a force (col. 6, lines 25-30), selectively controlling a flow of fluid through the apparatus by the valve (col. 6, lines 45-70); and destructively (connection of 41 to 36) removing the apparatus including the valve out of the well.

As to claims 3, 19 and 30, Cherry et al. discloses the tab (330) selectively engaging the mandrel (312 at 68) when the valve (75) is in the closed position.

As to claims 16-18 and 31, Cherry et al. discloses a central member (335) is adapted to seal the passage and allow fluid flow when released, and hold (fig 9, 335 and 312) a valve (75) open during run-in.

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 41 and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Hernandez et al., U.S. 2004/0000407 A1.

Regarding claims 41 and 42, Hernandez et al. discloses a valve (14), a mandrel (16); a hinge (24) pivotally attaching the flapper to the mandrel, a tab (26) engaging a recession (31), wherein the flapper is biased in a closed position by a spring [0019].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cherry et al., U.S. 3,375,874.

As to claims 10 and 11, Cherry et al. discloses all the claimed limitations except for the flapper comprising structural grade plastic. However it would have been obvious to arrange for the flapper disclosed by Cherry et al. to include plastic, since the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Claims 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hernandez et al., U.S. 2004/0000407 A1.

As to claims 43 and 44, Hernandez et al. discloses all the claimed limitations except for the flapper comprising structural grade plastic. However it would have been obvious to arrange for the flapper disclosed by Hernandez et al. to include plastic, since the selection of a known

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material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Allowable Subject Matter

Claims 2, 4-9, 12-15, 20-28, 32-37, 39 and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not disclose or suggest all the claimed subject matter including a non-circular valve.

The prior art of record does not disclose or suggest all the claimed subject matter including a hinge pivotally connecting the flapper to the mandrel.

The prior art of record does not disclose or suggest all the claimed subject matter including a central member within the passage.

The prior art of record does not disclose or suggest all the claimed subject matter including the mandrel having a non-circular cross-section and the packer having a non-circular inner surface precluding relative rotation.

The prior art of record does not disclose or suggest all the claimed subject matter including milling the apparatus out of the well, the flapper of the apparatus being comprised of non-metallic material to facilitate the milling.

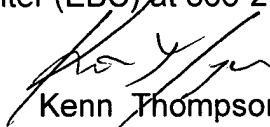
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenn Thompson whose telephone number is 571 272-7037. The examiner can normally be reached on 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

28 September 2005


Kenn Thompson
Primary Examiner
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